

## **REMARKS<sup>1</sup>**

In reply to the Office Action mailed February 6, 2008, Applicants have amended claim 21 and canceled claims 60-61. After entry of this paper, claims 21-41 remain pending in the application.

### **Priority**

In the Office Action, the Examiner indicated that certain claim limitations in the claims are not disclosed in U.S. Application No. 08/388,107 ("the '107 application"), of which the current application is a continuation-in-part, and thus refused to grant priority to the '107 application. Applicants respectfully submit that the Examiner's action is inappropriate in a continuation-in-part application. MPEP § 201.08 provides that "unless the filing date of the earlier nonprovisional application is actually needed, for example, in the case of an interference or to overcome a reference, there is no need for the Office to make a determination as to whether the requirement of 35 U.S.C. 102, that the earlier nonprovisional application discloses the invention of the second application in the manner provided by the first paragraph of 35 U.S.C. 112, is met and whether a substantial portion of all of the earlier nonprovisional application is repeated in the second application in a continuation-in-part situation. Accordingly, an alleged continuation-in-part application should be permitted to claim the benefit of the filing date of an earlier nonprovisional application if the alleged continuation-in-part application complies with the other requirements of 35 U.S.C. 120 and 37 CFR 1.78."

 (emphasis added.) In other words, an applicant should be able to claim the benefit of an earlier

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<sup>1</sup>The Office Action contains statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

nonprovisional application in a continuation-in-part application if certain administrative details are satisfied and so long as there is no intervening reference. (See MPEP § 201.08; See also *In re Shaw*, 202 USPQ 285, 292-293 (PTO Dep. Com'r 1978), "alleged continuation-in-part application should be permitted to claim benefit of earlier U.S. application's filing date if alleged continuation-in-part application complies with formal requirements of 35 U.S.C. 120 that first application and alleged continuing application were filed 'by the same inventor,' alleged continuing application was 'filed before the patenting or abandonment of or termination of proceedings on the first application or an application similarly entitled to the benefit of the filing date of the first application,' and alleged continuing application 'contains or is amended to contain a specific reference to the earlier filed application.'") Each of the references relied on by the Examiner in the Office Action appears to have an earlier priority date than the parent application. Therefore, it is not appropriate for the Examiner to determine whether the continuation-in-part application is entitled to the parent application's priority date.

#### **Information Disclosure Statement**

In the Office Action, the Examiner indicated that the Information Disclosure Statement filed April 10, 2006, fails to comply with 37 CFR § 1.98(a)(2), as it fails to include a legible copy of each non-patent literature publication. Applicants have reviewed the references submitted on April 10, 2006 in the Patent Office's PAIR system, which should contain the same content available to the Examiner in eDan, and found that the version available online is legible. If the Examiner requests new copies of the references, Applicants can resubmit the references.

In the Office Action, the Examiner also refused to consider three references (U.S. Pat. Nos. 3,946,200, 4,727,550, 5,227,797) submitted in the Information Disclosure Statements dated November 23, 2005. Applicants have submitted the November 2005 IDS in a good faith attempt to alert the Examiner to all possible prior art. While all of the art cited in the IDS may not immediately appear to the Examiner to be relevant to the present application, Applicants seek to avoid future accusations that Applicants withheld references from the present examiner that they submitted to others in co-pending matters. PTO procedures and Federal Circuit precedent encourage Applicants to err on the side of cautiousness. See, e.g., MPEP § 2004 ("When in doubt, it is desirable and safest to submit information. Even though the attorney, agent, or applicant doesn't consider it necessarily material, someone else may see it differently and embarrassing questions can be avoided. The court in *U.S. Industries v. Norton Co.*, 210 USPQ 94, 107 (N.D. N.Y. 1980) stated 'In short, the question of relevancy in close cases, should be left to the examiner and not the applicant.' See also *LaBounty Mfg., Inc. v. U.S. Int'l Trade Comm'n*, 958 F.2d 1066, 22 USPQ2d 1025 (Fed. Cir. 1992).") As seen above, the Federal Circuit and the PTO both encourage applicants to submit references that may possibly be relevant. Consistently, the Examiner should be required to consider and initial these references submitted by the Applicants. Accordingly, Applicants respectfully request the Examiner to consider the three references in the IDS submitted in November 2005, and initial the three references with the Office's subsequent communication.

### **Specification**

The specification has been objected to as failing to provide proper antecedent basis for the claimed subject matter “computer readable medium” in claims 60-61. Although, Applicants respectfully disagree with the Examiner’s assertion, in the interest of expediting the examination, Applicants have canceled claims 60-61. Thus, the objection is now moot.

#### **Claim Rejections 35 U.S.C § 101**

Claims 60-61 have been rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Although Applicants respectfully disagree with the Examiner’s rejection, as stated above, in the interests of expediting prosecution of this application, Applicants have canceled claims 60-61. Thus, the rejection is now moot.

#### **Claim Rejections 35 U.S.C § 102**

Claims 21-23, 26-27, 32-33, 36-41 and 60-61 have been rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,659,616 to Sudia (“Sudia”).

Independent claim 21 recites a method for providing access to an online service including, *inter alia*, “determining, based at least in part on [a] first digital certificate, whether the user is authorized to access the online service; and if the user is determined by said determining step to be authorized to access the online service, issuing a second digital certificate to the user, the second digital certificate attesting to the user’s permission to access the online service.” Although Sudia discloses the verification of a transaction based on information in an identifying certificate (see, e.g., Sudia, claim 1), Sudia does not disclose, *inter alia*, issuing a second certificate to the

user if the user is determined, based at least in part on a first digital certificate, to be authorized to access the online service, the second digital certificate attesting to the user's permission to access the online service, as recited in Applicants' claim 21. For at least these reasons, Applicants respectfully request that the rejection of claim 21 be withdrawn.

Claims 22-23, 26-27, 32-33, and 36-41 ultimately depend from claim 21 and include all the aspects of claim 21. Therefore, claims 22-23, 26-27, 32-33, and 36-41 are patentable over Sudia for at least the same reasons as set forth above with claim 21.

In addition, with regard to claim 23, in particular, the passage from Sudia cited by the Examiner (i.e., the abstract), provides no indication that the step of checking a digital certificate to determine whether a user has permission to access an online service would be "performed in protected processing environment at a local computer system from which the user made the request to access the online service," as recited in claim 23. Instead, Sudia appears to disclose a system in which evaluation of a user's digital signature is performed at the remote computer system to which the user sends a request, not the local computer system from which the user sent the request (see, e.g., Sudia at col. 9, lines 36-46).

#### **Claim Rejections 35 U.S.C § 103**

Claims 24-25 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Sudia in view of U.S. Patent No. 5,956,408 to Arnold ("Arnold"). Claims 24-25 ultimately depend from claim 21. As discussed above with respect to claim 21, Sudia fails to teach, *inter alia*, "determining, based at least in part on [a] first

digital certificate, whether the user is authorized to access the online service; and if the user is determined by said determining step to be authorized to access the online service, issuing a second digital certificate to the user, the second digital certificate attesting to the user's permission to access the online service." Arnold, which is cited as allegedly teaching sending software to a user and sending a digital signature for determining the integrity of the software to the user, fails to cure the deficiency of Sudia. Therefore, for at least this reason, claims 24-25 are patentable over Sudia in view of Arnold.

Claim 28 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Sudia in view of U.S. Patent No. 5,537,618 to Boulton et al. ("Boulton"). Claim 28 depends from claim 21. As discussed above with respect to claim 21, Sudia fails to teach, *inter alia*, "determining, based at least in part on [a] first digital certificate, whether the user is authorized to access the online service; and if the user is determined by said determining step to be authorized to access the online service, issuing a second digital certificate to the user, the second digital certificate attesting to the user's permission to access the online service." Boulton, which is cited as allegedly teaching that age is an attribute of a user, also fails to cure the deficiency of Sudia. Therefore, for at least this reason claim 28 is patentable over Sudia in view of Boulton.

Claims 29-31 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Sudia in view of the Examiner's Official Notice. Claim 29 depends from claim 21, claim 30 depends from claim 29, and claim 31 depends from claim 30. Therefore, claims 29-31 are patentable for at least the same reasons set forth above in connection with claim 21.

Claims 34-35 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Sudia in view of U.S. Patent No. 5,978,567 to Rebane et al. ("Rebane"). Claim 34 depends from claim 21 and claim 35 depends from claim 34. As discussed above with respect to claim 21, Sudia fails to teach, *inter alia*, "determining, based at least in part on [a] first digital certificate, whether the user is authorized to access the online service; and if the user is determined by said determining step to be authorized to access the online service, issuing a second digital certificate to the user, the second digital certificate attesting to the user's permission to access the online service." Rebane, which is cited as allegedly teaching an interactive online game, also fails to cure the deficiency of Sudia. Therefore, at least for this reason, claims 34-35 are patentable over Sudia in view of Rebane.

**Conclusion**

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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By.



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